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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,725	11/30/2001	Wely B. Floriano	06618-607002	4307
20985	7590	05/04/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			LY, CHEYNE D	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/010,725

Applicant(s)

FLORIANO ET AL.

Examiner

Cheyne D. Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 12 April 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-6,8-16,29,31 and 36-45.
Claim(s) withdrawn from consideration: 17-28,30 and 32-35.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE: The proposed amendment to introduce the limitation of "a set of configurations...a course-grained docking" to claims 1, line 8, raises new issues that would require further consideration and/or search. It is noted that the proposed amendment is a new limitation being introduced to the claim. The new limitation would require a new search if said amendment is entered. The same issue is present in claims 4 and 31. Further, the deletion of "preliminary" limitation from claim 4, line 7, and "a secondary preliminary" limitation from claim 5, line 4, requires new searches because the scope of the instant claims are different from the claims as previously recited.

Continuation of 11. does NOT place the application in condition for allowance because:

Claims 1-6, 8-16, 29, 31, and 36-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. NEW MATTER REJECTION.

This rejection is maintained with respect to claims 1-6, 8-16, 29, 31, and 36-45, as recited in the previous office action mailed October 13, 2004.

On pages 12-13, Applicant argues via amendment to overcome the instant rejection. The proposed amendments to claims 1, 4-6, 31, and 36, have been fully considered and found to be unpersuasive because of the non-entry of said amendment as discussed above. Therefore, the non-entry of the amendment leaves the claims as previously set forth and properly rejected as previously rejected.

It is noted that the proposed amendment has written description basis support as pointed to by Applicant. The proposed amendment would overcome the instant rejection, if entered.

Claims 1-6, 8-16, 29, 31, and 36-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory algorithm type subject matter.

This rejection is maintained with respect to claims 1-6, 8-16, 29, 31, and 36-45 as recited in the previous office action mailed October 13, 2004.

On page 13, Applicant argues via amendment to overcome the instant rejection. The proposed amendment to claim 1 has been fully considered and found to be unpersuasive because of the non-entry of said amendment as discussed above. Therefore, the non-entry of the amendment leaves the claims as previously set forth and properly rejected as previously rejected.

It is noted that the proposed amendment would not overcome the instant rejection, if the proposed amendment has been entered, because the claimed invention is directed to a computer implemented method comprising steps for manipulating ligand-protein binding data without any physical alteration step, which is considered to be non-statutory subject matter.

Claims 1-6, 8-16, 29, 31, and 36-45 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Zou et al. (1999).

This rejection is maintained with respect to claims 1-6, 8-16, 29, 31, and 36-45 as recited in the previous office action mailed October 13, 2004.

On page 15, Applicant argues that Zou et al. does not disclose the claimed method comprising the proposed limitation of "a set of configurations...a course-grained docking." Applicant argument is not persuasive because of the non-entry of the proposed claim amendment. Therefore, the non-entry of the amendment leaves the claims as previously set forth and properly rejected as previously rejected.

It is noted that the proposed amendment would not overcome the instant rejection, if the proposed amendment has been entered, because the instant specification does not specifically define the limitation of "a set of configurations...a course-grained docking." For example, the pointed to support provides exemplary disclosure for said limitation such "known Monte Carlo or matching techniques." Therefore, the citation of Zou et al. in the previous Office Action would anticipate the proposed limitation as exemplified by the instant specification, if entered. For example, Zou et al. relies on the general GB/SA model to compute ligand binding energies wherein the parameters are approximated by a linear dependence on the solvent-accessible surface area and dielectric properties around the binding site as directed to the unoccupied embedded space (page 8034, II. Method §, column 2, to page 8035, column 1, line 26). Using the method of Zou et al., the first set of parameters yields the best-fit binding energies six inhibitors (subset). TMP and MTX rank no. 1 and no. 2 among top scoring 10,000 ACD molecules for dhfr (page 8040, column 1, lines 10-19)

Continuation of 13. Other: It is noted that the proposed cancellation of claims 17-28,30 and 32-35 has not been entered because of the non-entry of the claim amendment as discussed above.

CM
4/26/05

Ardin H. Marschel
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PRIMARY EXAMINER 4/30/05